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PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q56369

Hiroshi OMURA

Appln. No.: 09/425,617

Group Art Unit: 2615

Confirmation No.: 9804

Examiner: Lin YE

Filed: October 22, 1999

For: PORTABLE PRINTER AND CAMERA

SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. A check for the statutory fee of \$500.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

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Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Fuji Photo Film Co., Ltd. Assignment of the application was submitted in U.S. Patent and Trademark Office on January 12, 2000, and recorded on the same date at Reel 010534, Frame 0579.

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II. RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

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III. STATUS OF CLAIMS

Claims 1-4 and 7-11 are all of the claims pending in the application. Pending claims 1-4 and 7-11 are rejected, and are the subject of this appeal. All of the claims are set forth in the attached Appendix.

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IV. STATUS OF AMENDMENTS

No amendments were requested subsequent to the Final Office Action of December 23, 2004.

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V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention is directed to a portable, handheld printer having an image processing function for producing standardized ID photographs. (page 1, lines 2-7).

Claim 1 recites:

printing means (14, 41, 42, 45) for printing an image on a recording medium 11 (Figs. 3 and 4; page 9, line 26 - page 10, line 24; page 20, line 16 - page 21, line 21);

driving means (40, 50) for driving the printing means based on digital image data (Fig. 4; page 15, lines 6 - 14; page 20, line 1 - page 21, line 21);

image processing means (50, 55) for extracting image data pieces representative of a human subject from image data of an image frame (Fig. 4; page 22, line 16 - page 23, line 6), and processing the image data pieces of the human subject such that the human subject is printed on the recording medium in a designated size at a designated position, the image processing device replacing image data pieces other than those of the human subject with blanking data to delete any other subject contained in the image frame (page 23, line 7 - page 25, line 7), wherein the driving means drives the printing means in accordance with the image data processed by the image processing means, to print the human subject onto the recording medium in the designated size at the designated position with a blanked background (page 25, line 20 - page 26, line 2);

means for portably housing said printing means, said driving means and said image processing means (Figs. 1-3);

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a mode selection device (9) for selecting a normal mode for driving the printing means on the basis of the image data of the image frame to print a picture frame corresponding to the image frame, or a second mode for making an identification photograph for identifying a person by driving the printing means on the basis of the image data processed by the image processing means to print a picture frame containing the human subject with the blanked background (page 9, lines 19-25; page 20, lines 1-15); and

a selection device (9) for selecting a type of the identification photograph to make from among predetermined options, wherein the size and position of the human subject and a picture frame size are automatically designated by the selected type of identification photograph, and the size and position of the human subject and the picture frame size are stored in an internal memory 66 (page 22, line 16 - page 26, line 13).

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 1-3 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook (U.S. Patent No. 6,476,863) in view of Cullen et al. (U.S. Patent No. 5,781,665; hereafter "Cullen") and Oka et al. (U.S. Patent No. 5,867,738; hereafter "Oka").

B. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook in view of Cullen, Oka and McIntyre (U.S. Patent No. 6,191,815).

C. Claims 7-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook in view of Cullen, Oka and Douglas (U.S. Patent No. 5,946,031).

D. Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook in view of Cullen, Oka and Suzuki (U.S. Patent No. 5,847,836).

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VII. ARGUMENT

A. Rejection of claims 1-3 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook in view of Cullen and Oka.

It is respectfully submitted that claims 1-3 and 11 are patentable over the Examiner's proposed combination of Silverbrook, Cullen and Oka for at least the following reasons.

With regard to independent claim 1, the Examiner asserts that Silverbrook and Cullen disclose all of the features of the claimed invention except for the claimed "selection device for selecting a type of the identification photograph to make from among predetermined options, wherein the size and position of the human subject and a picture frame size are automatically designated by the selected type of identification photograph, and the size and position of the human subject and the picture frame size are stored in an internal memory." However, the Examiner cites Oka for allegedly disclosing this feature of the claimed invention which is absent from Silverbrook and Cullen, and asserts that it would have been obvious to modify Silverbrook based on the alleged disclosure of Oka because "the Oka reference is evidence the one of ordinary skill in the art at the time to see more advantage for the printer system have more flexible option to let user to select any type of identification photograph and the size and position of the human subject and a picture frame size are automatically designated by the desired type of identification photograph."¹

However, Appellant respectfully submits that independent claim 1 should be allowable over Silverbrook, Cullen and Oka because the cited references, alone or in combination, do not teach or

¹ December 23, 2004 Office Action at pages 4 and 5.

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suggest that the position of the human subject is automatically designated by the selected type of identification photograph and stored in an internal memory, as required by claim 1. In particular, Oka, which the Examiner cites for allegedly disclosing these claimed features, simply discloses processing the image data to produce a desired picture size, i.e., scaling/resizing the image data to passport size or visa size. In Oka, the position of the human subject in the photograph is determined by an orientation of a camera and a seated position of the human subject within a photo booth.

The Examiner maintains that Appellant's argument for patentability is not persuasive because Oka allegedly discloses:

the Oka reference discloses **both size and position** of the human subject and a picture frame size automatically designated by the selected type of identification photograph. Please see Figure 36 of the Oka reference, after shooting the image, the CPU (421, see Figure 35 and Col. 14, lines 61-64) automatically editing the image data (See Col. 13, lines 58-61), such as the size and position of the human subject (e.g., in Figure 34, the size and position of the human subject of passport are different from the size and position of the human subject of the Visa, i.e., **the passport cutline marking 424 starts in difference position compared with Visa cutline marking 424, therefore the position of human subject is based on the selected type of identification photograph**) and a picture frame size (a passport size 45mmx35mm and a visa 50mmx50mm) designated by the selected type of identification photograph, and the size and position of the human subject and the picture frame size (e.g., the patterns 420 for passport, visa or any type of identification photograph, see Col. 16, lines 1-3) are stored in an internal memory (e.g., microcomputer 415 has an internal memory inherently and can store the patterns 420 for passport, visa or any type of identification photograph in order

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the CPU 421 automatically processing the image data corresponding to the selected type of identification photograph).²

Appellant respectfully submits that the Examiner's characterizations of the teachings of Oka are incorrect. In particular, Appellant respectfully submits that it is quite clear that Oka does not teach or suggest automatically designating the position of the human subject based on the selected type of identification photograph. Instead, Oka only discloses changing the size of the image data of the entire photograph based on the selected type of the identification photograph.

As shown in Fig. 33, Oka discloses an automatic photographic processor apparatus 401 including a booth 402 divided by a partition 403 into two spaces, a machine room 404 and a shooting room 405. The shooting room 405 is provided with a stool 412, a back rest 433, and button-switch controls (not shown) so that a person 411 (who wants identification photos) faces a video camera 413 disposed in the machine room behind a window 407 of the partition 403 when seated on the stool 412. The video camera 413 captures an image of the person 411 seated on the stool 412 through a half mirror (not shown) and resultant captured image is displayed in real time on a visual display terminal (VDT) 414. If the displayed image is accepted by the person 411, it is transferred as image data having a size of 64 mm x 48 mm to a CPU 421 of a microcomputer 415 processes the image data to produce a specified size (e.g., passport or visa) for printing. (see Figs. 33-36 and column 14, line 11 - column 15, line 15 of Oka)

If the specified size is passport size (i.e., 45 mm x 35 mm), the image data of 64 mm x 48 mm is scaled down in the CPU 421 by reducing the 48 mm width to 35 mm. When the 48 mm

² April 20, 2005 Advisory Action at pages 2 and 3.

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width of the image data is reduced to 35 mm, the length of reduced image changes to 46.6 mm.

Then, the 46.6 mm length is trimmed by 0.8 mm on both sides to reduce the length to 45 mm.

Similarly, if the specified size is visa size (i.e., 50 mm x 50 mm), the image data of 64 mm x 48 mm is scaled up in the CPU 421 to produce a width of 50 mm which causes the length to change 66.6 mm. The 66.6 mm length is then trimmed by 8.3 mm on both sides to reduce the length to 50 mm. (see Figs. 33-36 and column 14, line 61 - column 15, line 15 of Oka).

Accordingly, Oka's operations of changing the size of the image data based on the specified size of the photograph to be printed do not automatically designate the position of the human subject based on the selected type of identification photograph, as required by the claims. That is, the position of the human subject remains constant regardless of any change in size of the image data. For example, if the position of the human subject is offset in the original captured image, the human subject will have the same offset position in both the passport size image and the visa size image (i.e., Oka's resizing/scaling operation does not reposition the human subject).

The Examiner's assertion that the cutline markings 424 markings shown in Fig. 34 are provided in different positions for the passport size images 416a and the visa size images 416b (it is believed that the Examiner may have meant to refer to the image borders 420a and 420b shown by dashed lines in Fig. 34, rather than the cutline markings 424) show "the position of the human subject is based on the selected type of identification photograph" is incorrect. The cutline markings 424 (the image borders 420a and 420b) simply denote horizontal and vertical edges the respective images which are set based on the specified sizes/dimensions of the images (i.e., 45 mm x 35 mm for passport size and 50 mm x 50 mm for visa size). While the size of the human

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subject is different in the passport size images 416a and the visa size images 416b, the position of the human subject remains the same since Oka only discloses performing a resizing/scaling operation on the image data as discussed above.

Further, as conceded by the Examiner, neither Silverbrook nor Cullen discloses that the position of the human subject is automatically designated by the selected type of identification photograph and stored in an internal memory. That is, Silverbrook discloses a camera including a removable card which functions as a user interface for manipulating and enhancing images captured by the camera without providing any details directed to passport photography or designating a position of a human subject. Cullen simply discloses an apparatus and method for cropping an image to remove portions of the image which contain relatively little detail (i.e., cropping an image of a person's face to remove the background).

Accordingly, Appellant respectfully submits that independent claim 1, as well as dependent claims 2, 3 and 11, should be allowable over Silverbrook, Cullen and Oka because the cited references, alone or in combination, do not teach or suggest all of the features of the claimed invention.

B. Rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook in view of Cullen, Oka and McIntyre.

Appellant respectfully submits that McIntyre does make up for the above noted deficiencies of Silverbrook, Cullen and Oka. Accordingly, Appellant respectfully submits claim 4 should be allowable over the cited references at least by virtue of its dependency on claim 1.

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C. Rejection of claims 7-9 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook in view of Cullen, Oka and Douglas.

Appellant respectfully submits that Douglas does make up for the above noted deficiencies of Silverbrook, Cullen and Oka. Accordingly, Appellant respectfully submits that claims 7-9 should be allowable over the cited references at least by virtue of their dependency on claim 1.

D. Rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook in view of Cullen, Oka and Suzuki .

Appellant respectfully submits that Suzuki does make up for the above noted deficiencies of Silverbrook, Cullen and Oka. Accordingly, Appellant respectfully submits claim 10 should be allowable over the cited references at least by virtue of its dependency on claim 1.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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CUSTOMER NUMBER

Date: July 5, 2005

Attorney Docket No.: Q56369

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CLAIMS APPENDIX

CLAIMS 1-4 and 7-11 ON APPEAL:

1. (Previously Presented) A portable, handheld printer comprising:
printing means for printing an image on a recording medium;
driving means for driving the printing means based on digital image data;
image processing means for extracting image data pieces representative of a human subject from image data of an image frame, and processing the image data pieces of the human subject such that the human subject is printed on the recording medium in a designated size at a designated position, the image processing device replacing image data pieces other than those of the human subject with blanking data to delete any other subject contained in the image frame, wherein the driving means drives the printing means in accordance with the image data processed by the image processing means, to print the human subject onto the recording medium in the designated size at the designated position with a blanked background;
means for portably housing said printing means, said driving means and said image processing means;
a mode selection device for selecting a normal mode for driving the printing means on the basis of the image data of the image frame to print a picture frame corresponding to the image frame, or a second mode for making an identification photograph for identifying a person by driving the printing means on the basis of the image data processed by the image processing means to print a picture frame containing the human subject with the blanked background; and
a selection device for selecting a type of the identification photograph to make from among predetermined options, wherein the size and position of the human subject and a picture

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frame size are automatically designated by the selected type of identification photograph, and the size and position of the human subject and the picture frame size are stored in an internal memory.

2. (Previously Presented) A portable, handheld printer as claimed in claim 1, wherein the image processing means processes the image data of the image frame such that a picture frame containing the human subject with the blanked background is printed on the recording medium in a designated frame size.

3. (Previously Presented) A portable, handheld printer as claimed in claim 1, wherein the image processing means processes the image data of the image frame such that the human subject with the blanked background is printed on the recording medium together with a cutting line surrounding the human subject, the cutting line showing a boundary of a picture frame of a designated frame size.

4. (Previously Presented) A portable, handheld printer as claimed in claim 2 or 3, wherein the image processing means determines how many picture frames can be printed on the same recording medium depending upon the designated frame size and a recording area of the recording medium, and processes the image data of the image data such that picture frames of the determined number are printed on the same recording medium.

5. (Canceled)

6. (Canceled)

7. (Previously Presented) A portable, handheld printer as claimed in claim 1, wherein the recording medium is an instant film, and the printing means optically prints the image on the instant film.

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8. (Previously Presented) A portable, handheld printer as claimed in claim 7, wherein the printing means comprises an LCD panel, three color light emission diodes for illuminating the LCD panel from its rear side, and a printing optical system for projecting an image displayed on the LCD panel toward the recording medium.

9. (Previously Presented) A portable, handheld printer as claimed in claim 8, further comprising a monitoring device for allowing to select and observe an image to print, wherein the image to print is displayed on the LCD panel and is observed through the monitoring device.

10. (Previously Presented) A portable, handheld printer as claimed in claim 1, wherein the printer may be loaded with a battery as a power source.

11. (Previously Presented) A portable, handheld printer as claimed in claim 1, further comprising an electronic imaging device for obtaining digital image data from a subject, and a memory for storing the image data by each frame.

12. (Canceled)

13. (Canceled)

14. (Canceled)

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EVIDENCE APPENDIX:

There has been no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other similar evidence.

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RELATED PROCEEDINGS APPENDIX

There are no related proceedings.